

REMARKS

I. Introduction

In response to the pending Office Action, as explained in further detail below, Applicants have revised the previous amendment to the specification such that the deleted subject matter is now indicated utilizing a single bracket as opposed to double brackets.

The claims pending in this application are claims 1-8, which correspond to the originally issued claims, and claims 16-25 which were previously added in this reissue application.

For the reasons set forth below, Applicants respectfully submit that the instant reissue application is in condition for allowance, an indication of which is respectfully solicited.

II. Failure Of Declaration To Specify An Error

The reissue oath/declaration was asserted to be defective for failing to “specifically identify the error” in the original patent. Applicants respectfully request reconsideration of this rejection. As noted in the previously filed declaration, claims 16-25 are directed to a novel resin-molded semiconductor device, which includes, among other elements, a semiconductor chip having electrode pads, a die pad for supporting the semiconductor chip, and inner leads each including a groove so as to define a reduced thickness portion. In a structure including such grooves, even if the lower surface of the signal-connecting leads is not covered with the resin encapsulant, the resin encapsulant can still hold the signal-connecting leads in a sufficiently strong/secure manner. The claims of the instant reissue application also recite that the resin is not formed on a bottom surface of the inner leads, nor a bottom surface of the die pad. Applicant desires to expressly claim the foregoing structure.

However, the original claims of USP No. 6,455,348 were only directed to a method of manufacturing the resin-molded semiconductor device, and therefore did not recite a resin-

molded semiconductor device having inner leads each including a groove, and also failed to recite a structure in which the resin is not formed on a bottom surface of the inner leads or on a bottom surface of the die pad. Further, it is noted that while USP No. 6,081,029 contained claims directed to a resin-molded semiconductor device, these claims also failed to recite inner leads each including a groove so as to define a reduced thickness portion, and also failed to recite a structure in which the resin is not formed on a bottom surface of the inner leads or on a bottom surface of the die pad. Thus, the original patents failed to include claims directed to the novel resin-molded semiconductor device having inner leads each including a groove, and in which the resin is only not formed on the bottom surface of the inner leads or the bottom surface of the die pad. Therefore, *the Applicant claimed less than he had a right to claim*, which is the error relied upon to support this reissue application.

Applicant respectfully submits that the foregoing error is specifically identified, and is a valid basis to support the reissue application. Indeed, clearly it is permissible to submit reissue applications for an error regarding the failure to claim subject matter that the Applicant was entitled to claim. The foregoing explanation makes it clear that is what occurred in the instant application. It is not clear to the Applicant how the error could be “specified” in any more detail. Accordingly, it is respectfully requested that the pending rejection of the declaration based on the failure to specifically identify the error in the original patent be withdrawn.

III. The Assent Of Assignee

The previously filed Assent of Assignee was objected to on the basis that there was no official record that the USP No. 6,455,348 (the ‘348 patent) was assigned to Panasonic Corporation (formerly Matsushita Electric Industrial, Co., Ltd.). The objection states that the patent is assigned to Matsushita Electronics Corporation. However, this is incorrect. As

indicated in the USPTO assignment database, the ownership of the '348 patent was transferred to Matsushita Electric Industrial, Co., Ltd. via an assignment recorded on January 18, 2002. A copy of the USPTO assignment records are enclosed for the Examiner's convenience. Further, a copy of the documentation regarding the name change of Matsushita Electric Industrial, Co., Ltd. to Panasonic Corporation is also enclosed.

In view of the foregoing and the enclosed documentation, it is respectfully submitted that the previously filed Assent of Assignee is proper and in compliance with 37 C.F.R. § 1.172.

IV. The Present Application DOES NOT Violate the Two Year Rule

It is asserted in the pending rejection that the instant reissue application is improper as it violates the "two-year limitation" regarding broadening reissue applications. Applicant submits that this conclusion is in error for at least the following reasons.

Most importantly, as expressly set forth in § 1412.03.IV of the M.P.E.P.:

A broadened claim can be presented within two years from the grant of the original patent in a reissue application. In addition, a broadened claim can be presented *after* two years from the grant of the original patent in a broadening reissue application which was filed *within* two years from the grant. Where any intent to broaden is unequivocally indicated in the reissue application within the two years from the patent grant, a broadened claim can subsequently be presented in the reissue after the two year period. **Thus, a broadened claim may be presented in a reissue application after the two years, even though the broadened claim presented after two years is different than the broadened claims presented within the two years.** Finally, if intent to broaden is indicated in a parent reissue application with the two years, a broadened claim can be presented in a continuing (continuation or divisional) reissue application after the two year period. (Emphasis added).

Thus, the M.P.E.P. makes it expressly clear that it is permissible to file a broader claim in a reissue application after the two year period as long as the intent to broaden is indicated prior to the expiration of the two year period. It is noted that the M.P.E.P. also expressly states that it is permissible to file a broader claim in a continuation or divisional reissue application after expiration of the two year period as long as the parent reissue application filed within the two year period indicated the intent to broaden the claim.

The basis for the pending rejection is that the claims of the instant application, since they are directed to a device, should have been filed within two years of the issuance of USP No. 6,081,029. However, this conclusion is clearly incorrect as there is no legal basis to support such a requirement.

The instant reissue application is based on USP No. 6,455,348 (which is a divisional application of the '029 patent). The '348 patent fully supports the subject matter of the claims of the instant reissue application. The instant reissue application was also filed within two years of the issuance of the '348 patent and clearly indicated that the Applicant intended to obtain broader claim coverage. Thus, the requirements set forth in the M.P.E.P. regarding the filing of the reissue application containing broader claims within the two year period was clearly satisfied by the filing of the instant reissue application (i.e., Ser. No. 10/761,091).

Furthermore, there is simply no legal basis (it is noted that the pending rejection does not provide any legal cite to support its position) to support that the two year period for filing broadening claims began running upon issuance of the '029 patent. As noted above, the instant reissue application is fully supported by the '348 patent, indicated the Applicant's desire to broaden the claims, and was filed within the two year period from the issuance date of the '348 patent. Clearly, if the '029 patent did not exist, there would be no question that the instant reissue application was proper. However, the existence of the '029 patent does not change this conclusion, as there is no legal support for the proposition that earlier issued patents in a chain of continuation or divisional patents may affect the expiration date of the two year period applicable to filing reissue applications containing broader claims. With regard to such reissue applications, each issued patent stands alone and a broadening reissue application can be filed within the two period for any subject matter supported by the individual patent.

For the foregoing reasons, it is respectfully submitted that the pending rejection is clearly in error and should therefore be withdrawn. In the event that this rejection is maintained, the Examiner is respectfully urged to cite legal authority to support his position.

V. The Present Application DOES NOT Violate the Recapture Rule

Claims 16-25 were rejected under 35 U.S.C. § 251 as being improper recapture of broadened claimed subject matter surrendered in the parent application. Applicants respectfully submit that applying the relevant test set forth by the Federal Circuit makes it clear that the rejected claims do not violate the recapture doctrine.

In formulating the pending rejection, four Federal Circuit cases are cited in support of the rejection, *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366 (Fed. Cir. 2001); *Hester Industries v. Stein, Inc.*, 142 F.3d 1472 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464 (Fed. Cir. 1997); *Ball*

Corp. v. United States, 729 F.2d (Fed. Cir. 1984). However, upon review of each of these cases, it is clear that application of the test for determining if reissue claims are attempting recapture subject matter surrendered to obtain the original patent leads to the conclusion that the rejected claims are not attempting to recapture surrendered subject matter.

As stated by the Federal Circuit, the test for determining whether the recapture has been violated is essentially a three step test. As stated by the Court in *In re Clement*, the first step is to determine whether and in what aspect the reissue claims are broader than the original patent claims (i.e., the claims that issued in the patent on which the reissue application is based). *In re Clement*, 131 F.3d at 1468. The second step is to determine whether the broader aspects of the reissue claims relate to surrendered subject matter. This is done by analyzing the prosecution history and previous amendments to determine what subject matter was surrendered. In other words, the second step entails determining whether the surrendered subject matter has crept into the reissue claim. *In re Clement*, 131 F.3d 1469.

With regard to the second step, as stated by the Federal Circuit in *In re Clement*, this is accomplished by "*comparing the reissue claim with the cancelled claim*". *Id.* at 1469. The Court further stated that if the scope of the reissue claim is the same or broader than the cancelled claim, the patentee is attempting to recapture surrendered subject matter and the reissue claims cannot be allowed. However, *if the reissue claim is narrower in scope than the cancelled claim, the recapture rule is not applicable*. *Id.* at 1469. (See also, *Ball Corp*, 729 F.2d at 1436, "[T]he patentee is free to acquire, through reissue, claims that are narrower in scope than the cancelled claims".)

Turning to the currently rejected reissue claims, as will be explained in more detail below, the pending reissue claims are unquestionably narrower than the cancelled claims, and therefore, the recapture rule is not applicable to the reissue claims. It would seem that in

applying the foregoing recapture test, the Special Programs Examiner, mistakenly compared the reissue claims to the original issued patent claims, and not the cancelled claims. This led to the erroneous conclusion that the reissue claims were broader, and therefore the recapture doctrine was applicable. However, while the reissue claims are broader than the originally issued claims in some respects, they are unquestionably narrower than the claims surrendered during prosecution, and therefore the recapture doctrine is not applicable.

Applying the foregoing test to reissue claim 16, which corresponds, for example, to claim 6 of the '029 patent, it is clear that reissue claim 16 is broader than originally issued claim 6, as claim 16 does not recite that the support lead functions as a spring as noted in the rejection. Thus, the next step of the test is to determine if the reissue claim is broader or narrower than the cancelled claim.

Prior to the amendment filed on January 7, 2000, claim 6 of the patent read as follows:

Claim A: A resin-molded semiconductor device comprising:

a semiconductor chip having electrode pads;

a die pad for supporting the semiconductor chip thereon;

support leads for supporting the die pad;

signal-connecting leads;

connecting members for electrically connecting the electrode pads of the semiconductor chip to the signal-connecting leads; and

a resin encapsulant for encapsulating the die pad, the semiconductor chip, the signal-connecting leads and the connecting members,

wherein respective lower parts of the die pad and the signal-connecting leads are at least partially not covered with the resin encapsulant but exposed, the support leads are provided between the die pad and the signal-connecting leads.

The amendment filed on January 7, 2000, which added the limitation that "each said support lead is partially bent to function as a spring", placed the claim in condition for allowance. Accordingly, Claim A represents the "surrendered" subject matter of the '029 patent application.

Comparing Claim A to claim 16 of the instant reissue application, it is clear that claim 16 is narrower than Claim A. For example, claim 16 recites inner leads that include a groove formed therein so as to define a reduced thickness portion. Claim 16 further recites that the resin is not formed on the bottom surface of the inner leads, nor a bottom surface of the die pad. Neither of these limitations are recited by Claim A.

As such, in accordance with the test set forth by the Federal Circuit, the recapture rule is not applicable to claim 16, as claim 16 is more narrow than the subject matter of Claim A, which was surrendered during the prosecution of the '029 patent. Moreover, as all other pending claims are dependent on claim 16, and therefore more narrow than claim 16, it is clear that the recapture rule is not applicable to any of the dependent claims.

VI. The Provisional Double Patenting Rejection

Upon indication of allowance of the pending claims, Applicant will submit the terminal disclaimer necessary to overcome the pending double patenting rejections.

VII. Summary

Having fully and completely responded to all open issues in the pending Office Action, Applicants submit that all claims are now in condition of allowance. Therefore, a notice of allowance is respectfully requested.

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Having fully and completely responded to all open issues in the pending Office Action, Applicants submit that all claims are now in condition of allowance. Therefore, a notice of allowance is respectfully requested.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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